

### Remarks

Claims 1-3, 5-13 and 22-24 are pending in this application. Claim 1 has been amended. Support for this claim amendment can be found throughout the specification, including, at least, page 12, lines 5-7, page 13, lines 13-19 and page 15, lines 5-10. No new matter is introduced by this claim amendment. After entry of this amendment, **claims 1-3, 5-13 and 22-24 are pending in the application, claims 8 and 22-24 being withdrawn.** No new matter is introduced by the foregoing amendments. Consideration and allowance of the pending claims are requested.

### *Telephone Interviews and Other Correspondence*

Applicants thank Examiner Calamita for the courtesy of a telephone interview with their representative, Karri Kuenzli Bradley, on February 6, 2009. During the telephone interview, the pending 35 U.S.C. §102(b) rejection was discussed. In particular, amendments to claim 1 to clarify that the sequestering of the molecules and the manipulation of the molecules occurred in an aqueous environment while in the external movement inhibitor device were discussed. Applicants' representatives noted that the cited art does not teach or suggest such a method. Applicants also thank Examiner Calamita for the detailed voicemail messages on February 12 and February 13, 2009, regarding the claim amendment proposed by Applicants' representative.

Complete agreement on claim amendments or arguments for overcoming the pending rejection was not reached. However, the Examiner provided helpful guidance and stated that she believed the claim amendments provided herewith overcame the cited art. As such, she agreed to consider claim amendments and arguments filed by Applicants in a response to the Office action. It is believed that this Amendment conforms to the spirit of the discussion had during the telephone interview.

### *Rejections under 35 U.S.C. §102(b)*

Claims 1-3, 5-7 and 9-13 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Kononen *et al.* (*Nature Medicine*, Vol. 7 (4): 844-847, 1998; hereinafter Kononen *et al.*). Applicants respectfully traverse this rejection for at least the following reasons.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983),

*cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

Presently, the Office has failed to satisfy the criteria for an anticipation rejection as set forth by *W.L. Gore & Assocs. or Lindemann Maschinenfabrik GMBH*, particularly with regard to the claims now pending in the case. Although the Office cites multiple pages within Kononen *et al.* to support the pending rejection, nowhere do Kononen *et al.* disclose, suggest or teach a method of analyzing the transcriptome of a tissue section comprising “sequestering molecules corresponding to a specific region or cell type of the tissue section in an aqueous solution contained within at least one of the plurality of grids or plurality of wells in the external movement inhibitor device,” or “manipulating molecules corresponding to a specific region or cell type of the tissue section in the aqueous solution while within the external movement inhibitor device,” as presently claimed.

The Office alleges that Kononen *et al.* disclose an external movement inhibitor (EMI). In particular, the Office states that “the EMI is the adhesive-coated tape sectioning system.” October 16, 2009, Office action, page 3. However, the method disclosed by Kononen *et al.* does not sequester molecules in an aqueous solution while within the plurality of grids or plurality of wells of the external movement inhibitor as presently claimed. Instead, the Kononen *et al.* method requires that the tissue section be transferred from the adhesive-coated tape sectioning system to a slide prior to the manipulation of the molecules. Moreover, the manipulation of the molecules does not occur while the sample is in the external inhibitor device, it occurs after the tissue has been transferred to a slide. Additionally, the manipulation of the molecules occurs while the molecules are bound to a surface (a slide), not while they are unassociated. The aqueous environment and manipulation of the molecules while within the external movement inhibitor device provided by Applicants’ disclosed method facilitates a number of molecular reactions that will not occur with bound molecules such as bound mRNA, DNA or proteins. Kononen *et al.* do not disclose each and every element of the claimed invention, particularly not as arranged in the claim. Therefore, the teachings of Kononen *et al.* are insufficient to establish anticipation.

In view of the above arguments, and the amendments made herewith, Applicants request withdrawal of the rejections under §102(b).

*Request for Rejoinder*

Applicants thank the Office for recognizing that claim 1 is a generic claim (Restriction Requirement, November 29, 2006). Applicants believe that the pending claims are in condition for allowance. Thus, Applicants request that withdrawn claims be rejoined as provided by 37 C.F.R. §1.141, which states that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which depend from or otherwise include all the limitations of an allowable generic claim.

**Conclusion**

Applicants respectfully submit that the claims submitted herewith are in condition for allowance. If any issues impede the issuance of a notice of allowance, Applicants expressly request that the Examiner contact the undersigned prior to the mailing of a subsequent action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution and allowance of the claims.

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Respectfully submitted,

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